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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,807	10/01/2003	Stephen Alan Smith	3177 P 387	3085
22908	7590	12/04/2006	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606				CASTELLANO, STEPHEN J
		ART UNIT		PAPER NUMBER
		3781		

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/676,807	SMITH ET AL.	
	Examiner	Art Unit	
	Stephen J. Castellano	3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 November 2006.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-31 and 43-46 is/are pending in the application.

4a) Of the above claim(s) 15-31 and 43-46 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 4-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

Claims 2, 3, 32-42 are canceled. Claims 1, 4-31 and 43-46 are pending.

Applicant's election with traverse of Group I in the reply filed on November 13, 2006 is acknowledged. The traversal is on the ground(s) that the examiner has not shown distinctness. This is not found persuasive because applicant's statement that a cup never stacked doesn't in and of itself, establish any utility over a stackable cup is conclusionary and is not based on reasoned analysis. Applicant's statement that the recess is only one element and doesn't serve as a basis for distinction between classes is not well taken. There is only the need to show one element that the combination doesn't require. This one element doesn't need to be shown to be separately classified. There is no error in the restriction and the restriction will be maintained.

The requirement is still deemed proper and is therefore made FINAL.

Claims 15-31 and 43-46 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 13, 2006.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-12, 14, 15 and 21-34 of copending Application No. 11/101932 to Smith et al. (Smith) in view of Hawley.

Smith discloses the invention except for the stacking of a second cup inside of a first cup. Hawley teaches the stacking. It would have been obvious to modify the single cup to have at least one other or multiple cups in a stacked or nested configuration to provide compact storage and transport for efficient packaging, storage and transport of cups. It would have been obvious to remove the claimed structure which is not claimed in the present invention from Smith as such structure is not necessary.

This is a provisional obviousness-type double patenting rejection.

Claims 1 and 4-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Design Patent No. D514385, D514380, D508822, D505830, D504593, D499935, D499934, D514884 all of these design patents, individually, in view of Hawley.

Each of these Smith design patents individually discloses the invention except for the stacking of a second cup inside of a first cup. Hawley teaches the stacking. It would have been obvious to modify the single cup to have at least one other or multiple cups in a stacked or nested configuration to provide compact storage and transport for efficient packaging, storage and

transport of cups. It would have been obvious to remove the claimed structure which is not claimed in the present invention from Smith as such structure is not necessary.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (D196271) in view of Hawley.

Edwards discloses a container comprising an open top defining an annular rim, a base defining a lowermost surface, a sidewall, the sidewall including a recess, an annular shoulder, the annular shoulder having arched portions, the annular shoulder forming the inner stacking surface on the inside of the container and the arched portions forming raised ledges on the inside of the container. Edwards discloses the invention except for the second stacked or nested container. Hawley teaches stacked or nested containers, the base of these containers being defined by a lowermost surface of the container, the stacking of the cups is such that the base of a second inner cup rests upon the inner stacking surface of a first outer cup. It would have been obvious to modify Edwards in two operations: (1) to add at least one other cup in a stacked or nested configuration to provide compact storage and transport for efficient packaging, storage and transport of cups (2) to modify the annular shoulder with arched portions to be moved to the lower base so that the base of each cup in the stack so that the base of a second, inner cup rests upon the inner stacking surface of a first outer cup. The raised ledge of the modified container of

the first outer cup sits within the arched portion of the modified container of the second, inner cup when nested.

Re claims 13 and 14, Official notice is taken that beveled portions are well known in the art. It would have been obvious to bevel portions of the base as such reinforces the junction of the base and sidewalls.

Applicant's arguments with respect to claims 1 and 4-14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Stephen J. Castellano  
Primary Examiner  
Art Unit 3781

sjc